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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/007,385 01/15/98 CHU

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HM12/0521

EXAMINER

WEATHERSPOON, J

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

05/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/007,385

Applicant(s)  
Chu

Examiner  
John K. Weatherspoon

Group Art Unit  
1645



☒ Responsive to communication(s) filed on Mar 22, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-21 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-21 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. Applicants' amendment and response dated 3/22/99 has been entered into the record as Paper No. 5. Claims 1-21 are pending and under examination.

#### ***Claim Objections***

2. The previous objection to claims 19-21 for use of the abbreviation "CFU" is withdrawn in view of applicants' amendment.

#### ***Claim Rejections - 35 USC § 102***

3. With regard to the previous rejection of claims 1, 2, 5, 10, 15, 17 and 19-21 under 35 U.S.C. 102(b) as being anticipated by either Timoney (U.S. Patent No. 5,183,659) or Timoney (PCT Publication WO 87/00436), applicants arguments have been fully considered but are not persuasive for the following reasons. Applicants argue that "nowhere do the Timoney references provide for an immunostimulant to be administered in addition to the attenuated *Streptococcus equi*". Applicants arguments are not persuasive since applicants' arguments are not commensurate in scope with the claimed invention, i.e. the claimed invention does not recite an immunostimulant to be administered "in addition" to live attenuated *Streptococcus equi*. Further, applicants argue that since instant claims 2, 5, 10, 15, 17 and 19-21 "contain all the limitations, features and attributes of claim 1", said claims should be found "non-obvious" over the cited art. Applicants argument is not persuasive since obviousness is not a basis for said

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102(b) rejection. Further, applicants arguments are not persuasive since it would be reasonable to conclude that *S.equi* strain 709-27 as disclosed by the Timoney references possesses the exact same properties as claimed strain 709-27, and set forth in the instant claims, since said Timoney references disclose use of the identical *S.equi* strain 709-27, and for the reasons as set forth in the previous Office Action. Further, applicants' arguments are not persuasive since applicants' addition of claim limitations in instant claim 1 and dependent claims thereof is drawn to *intended use* for the claimed composition and thus said claim limitations carry no patentable weight. For the reasons set forth above, said rejection as set forth in the previous Office Action is maintained.

4. With regard to the previous rejection of claims 1, 3, 10, 17 and 19-21 under 35 U.S.C. 102(a) as being anticipated by Hartford et al (European Patent Application No. EP 0 786 518 A1), applicants argue that claim 1 has been amended to recite additional claim limitations., i.e. use of claimed composition for vaccination of horses. Applicants' arguments are not persuasive given the disclosure of Hartford et al, as set forth in the previous Office Action, and further since applicants' addition of claim limitations in instant claim 1 and dependent claims thereof is drawn to *intended use* for the claimed composition, i.e. use of claimed composition for vaccination of horses, and thus said claim limitations carry no patentable weight. For the reasons set forth above, said rejection as set forth in the previous Office Action is maintained.

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***Claim Rejections - 35 USC § 103***

5. With regard to the previous rejection of claims 1-21 under 35 U.S.C. 103(a) as being unpatentable over either Timoney or Timoney in view of Hartford et al and Gerber (U.S. Patent No. 4,806,350), applicants argue that "all of claims 2-21 incorporate the limitations of claim 1" and thus said references cited by the examiner do not provide suggestion or motivation to make the vaccines of the claimed invention comprising a live attenuates *S.equi* and an immunostimulant given the further claim limitations as set forth in amended claim 1 and dependent claims thereof. Applicants arguments are not persuasive since it would be reasonable to expect that *S.equi* strain 709-27 as disclosed by the Timoney references possesses the exact same properties as claimed strain 709-27, and set forth in the instant claims, since said Timoney references disclose use of the identical *S.equi* strain 709-27, and for the reasons as set forth in the previous Office Action. Further, applicants arguments are not persuasive since applicants' addition of claim limitations in instant claim 1 and dependent claims thereof is drawn to *intended use* for the claimed composition, i.e. use of claimed composition for vaccination of horses, and thus said claim limitations carry no patentable weight. Further, applicants' argument that the Timoney references do not teach "a separate immunostimulant" is not persuasive since applicants' arguments are not commensurate in scope with the claimed invention, i.e. the claimed invention does not recite "a separate immunostimulant" to be administered with a live attenuated *Streptococcus equi*. For the reasons stated above, applicants arguments that the Hartford reference does not teach all the claim limitations of amended claim 1 are not persuasive since

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applicants' addition of claim limitations in instant claim 1 and dependent claims thereof is drawn to *intended use* for the claimed composition which carries no patentable weight. For the reasons set forth above, said rejection as set forth in the previous Office Action is maintained.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

#### **Status of Claims**

7. No claim is allowed.

8. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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Papers relating to this application may be submitted to Technology center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1645 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Weatherspoon, Ph.D. whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D., can be reached at (703) 308-3995.

John Weatherspoon, Ph.D.

May 20, 1999



Anthony Caputa, Ph.D.

Supervisory Primary Examiner

Group 1645